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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,915	01/17/2001	Yasuo Tano	4084-2163	5564

21888 7590 07/19/2004

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EXAMINER

BUI, VY Q

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/761,915	<b>Applicant(s)</b> TANO ET AL.	
	<b>Examiner</b> Vy Q. Bui	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,9-15 and 21-33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 28-33 is/are allowed.  
6) ☒ Claim(s) 1,3,4,7,9-15,21-27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Claim Rejections - 35 USC § 102

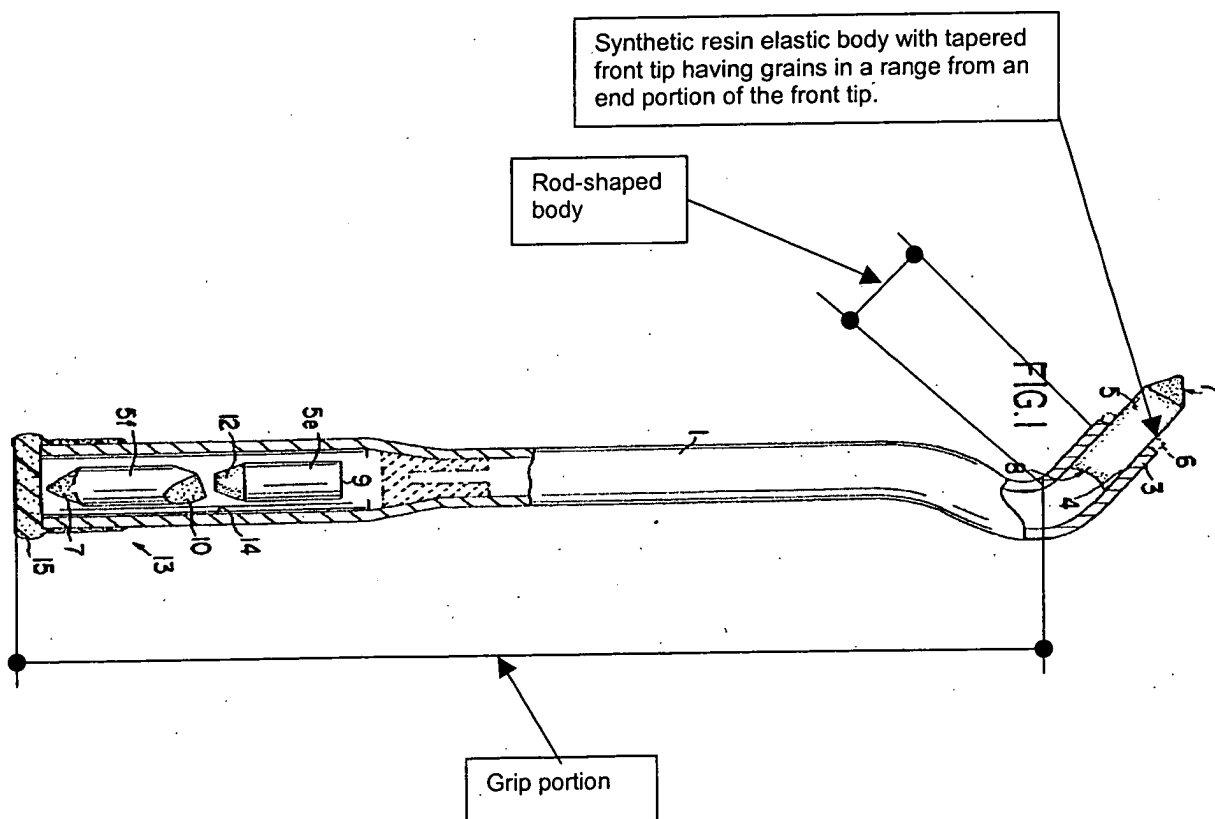
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by VARAINE (5,118,291).

As to claim 26, VARAINE (see Fig. 1 reproduced on next page; abstract) discloses every structural limitation as recited in the claim.



***Claim Rejections - 35 USC § 251***

Present independent claims 1, 9, 12, 21, and 26 and dependent claims 3-4, 7, 10-11, 13-15, 22-25 and 27 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim 1 (original application 09/058,183) was amended to recite (I). **“a hollow tapered front tip”** (see line 7, claim 1 of surrendered U.S. Pat. 5,921,998) and (II). **“grains are located in a range of 0.5mm to 3.0mm from an end portion of said front tip”** (see lines 8-12, claim 1 of surrendered U.S. Pat. 5,921,998) to overcome the 102(b) rejection entered on 12/04/1998 (application 09/058,183) as being anticipated by SHIMIZU (U. S. Pat. 3,809,101). In the argument filed 04/10/1998 (from line 13, page 5 to line 4, page 6 of attached Amendment A/#6, dated April 10, 1998), the applicants argued that SHIMIZU does not disclose the features (I) and (II) above, and therefore, amended claim 1 was clearly defined over SHIMIZU. The amendment and argument was presented to obviate the rejection and was convincing, therefore the amended claim 1 was allowed and issued in U.S. Pat. 5,921,998 with

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features (I) and (II) in claim 1 (see column 6, lines 8, and 11-12, U.S. Pat. 5,921,998).

According to the Applicants' argument filed 04/10/1998 (from line 13, page 5 to line 4, page 6 of attached Amendment A/#6, dated April 10, 1998), features (I) and (II) are considered as surrendered subject matters to over come the prior art of SHIMIZU rejection. See MPEP 1412.02.

Present independent claims 1, 9, 12, 21 and 26 now do not require the tapered tip or taper of the device to be hollow, nor require the range from 0.3 mm to 3.0mm for the grain to be fixed to the tapered tip or taper of the elastic body. The omission of the feature (I) and/or (II) above in the independent claims 1, 9, 12, 21 and 26 of the current application presents an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Present dependent claims 3-4, 7, 10-11, 13-15, 22-25 and 27 now do not include both features (I) and (II), therefore are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

### ***Allowable Subject Matter***

Claim 28 includes both surrendered features (I) and (II) and therefore is allowed. Claims 29-33 dependent to claim 28 are therefore allowed as well.

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***Response to Amendment***

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive because claim 26 was rejected for the first time under 102(b) over VARAINE U.S. Pat. No. 5,118,291 in the last rejection, therefore, the finality of that action is withdrawn.

Claim 26 has been rejected over VARAINE No. 5,118,291 the second time as indicated above, amended claims 28-33 have been allowed and the amendment 1/28/2004 has been entered.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

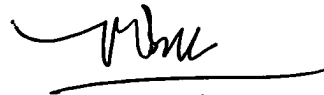
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott or Shaver can be reached on 703-308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
07/16/2004

Vy Q. Bui  
Primary Examiner  
Art Unit 3731